

## **REMARKS**

Applicants wish to thank the Examiner for reviewing the present patent application. Applicants acknowledge that the Board of Appeals and Patent Interferences has reversed the Examiner's prior rejection of claims 1, 2, 4-7, 9-12 and 14-18 over the references previously relied on. The Board's reversal is confirmed further in the erratum mailed 31 July 2006. The Examiner mentions in the present Office Action, which is non-final, that sufficient cause can be shown to justify the present non-final rejection after the Board's reversal of the previous rejection. The Examiner notes that there are no rejections made under 35 USC §112, second paragraph and that no obviousness-type double patenting rejections are of record.

Regarding the amendments made to the present claims, support for the same may be found, among other places, on page 36 of the specification as originally filed as well as in the claims as originally filed. Therefore, the amendments present no new matter and are made consistent with 35 USC §132.

The application now stands with three rejections made under 35 USC §103 and they will be addressed hereinbelow.

### **I. Rejection Under 35 USC §103**

The Examiner has rejected claims 1-2, 4-7, 9-12, 14-15 and 17 under 35 USC §103 wherein the Examiner alleges that the same are unpatentable over U.S. Patent No. 5,914,116 in view of U.S. Patent No. 5,965,518 and further in view of U.S. Patent No. 5,976,555 (hereinafter, '116, '518, '555, respectively). In the rejection, the Examiner mentions, in summary, that the '116 reference teaches a method for a skin treatment

regime and product that includes a first composition containing at least one active to impart a first skin benefit and a second composition that includes a second and different active that imparts a second benefit to skin. The Examiner mentions that the '116 reference teaches that the first and second compositions are stored in respective separate containers which are joined together. Even further, the Examiner mentions that the '116 reference provides examples of first compositions and second compositions where the first composition is a cleanser and the second composition is an anti-acne preparation and also where the first composition is sunscreen and the second composition is an anti-wrinkle cream.

The Examiner admits that the '116 reference fails in every way to disclose a second composition comprising a retinoid booster like citral, citronellol, etc. as recited in the claims. The Examiner also mentions that the '116 reference fails to specifically teach that the compartment having the composition with retinoid keeps the retinoid composition out of contact with oxygen.

In an attempt to "cure" the vast deficiencies of the '116 reference, the Examiner relies on the '518 reference and mentions that the same discloses a fragrance composition that includes non-aromatic terpenoid compounds such as citral, citronellol, geraniol and linalool and that the composition is suitable for various products. Thus, it is believed by the Examiner that one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the fragrances and fragrance compositions of the '518 reference in the compositions of the '116 reference and in particular in the sunscreen composition of the '116 reference.

The Examiner admits even further that the combination of the teachings of the '116 reference and the '518 reference does not render the claimed invention obvious since it

does not describe providing a compartment that keeps retinoid containing compositions out of contact with oxygen. Nevertheless, the Examiner relies on the '555 reference and states that the same describes that the oxidation of skin care compositions can be reduced by excluding oxygen permeation, and particularly, by fabricating container walls from aluminum.

Finally and in summary, the Examiner has reiterated the Board's conclusion in that the "thereby clause" is not construed as a limitation in the claimed invention. Based on the above, the Examiner believes that the rejection to claims 1-2, 4-7, 9-12, 14-15 and 17 under 35 USC §103 is warranted.

Notwithstanding the Examiner's apparent position to the contrary, it is the Applicants' position that the presently claimed invention is patentably distinguishable from the above-described for at least the following reasons.

Independent claim 1, as now presented and amended, is directed to a stable skin care product comprising a first composition comprising about 0.001% to about 10% of a retinoid selected from a group consisting of retinyl esters, retinol, retinal and mixtures thereof;

a second composition comprising about 0.0001% to about 50% of at least one retinoid booster selected from the group consisting of CITRAL, CITRONELLOL, COCAMIDE DEA, DAMASCONE, GERANIOL, 18b GLYCERHETINIC ACID, 8 OH QUINOLINE, N LAURY SARCOSINE, LINALOOL, ALPHA IONONE and LINSEED OIL;

a first compartment for storing the first composition and isolating the first composition from the second composition, wherein the first compartment keeps the first composition out of contact with oxygen; and

a second compartment for storing the second composition and isolating the second composition from the first composition, the first and second compartments being joined together,

the first composition not being chemically degraded by the second composition and not coming into contact with the second composition when being stored in the first compartment wherein the second composition potentiates the action of the retinoid upon contact.

The invention of claim 1 is further defined by the dependent claims which claim, among other things, that at least two retinoid boosters may be employed, and that skin may be conditioned with the compositions within the products described in claim 1.

Independent claim 6, as presented and amended, is directed to a stable skin care product comprising:

a first composition comprising about 0.01% to about 1% of a retinoid to provide a first benefit; said retinoid selected from a group consisting of retinyl esters, retinol, retinal, and mixtures thereof;

a second composition comprising about 0.0001% to about 50% of at least one retinoid booster to boost the first benefit;

said retinoid booster selected from the group consisting of CITRAL, CITRONELLOL, COCAMIDE DEA, GERANIOL, 18b GLYCERHETINIC ACID, 8 OH QUINOLINE, N LAURY SARCOSINE, LINALOOL, and LINSEED OIL;

a first compartment for storing the first composition and isolating the first composition from the second composition, wherein the first compartment keeps the first composition out of contact with oxygen; and

a second compartment for storing the second composition and isolating the second composition from the first composition, the first and second compartments being joined together;

the first composition not being chemically degraded by the second composition and not coming into contact with the second composition when being stored in the first compartment wherein the second composition potentiates the action of the retinoid upon contact.

The invention of claim 6 is further defined by dependent claims which claim, among other things, that at least two retinoid boosters may be employed and that the compositions within the skin care product can condition skin.

Independent claim 11, as presented and amended, is directed to a stable skin care product comprising:

a first composition comprising about 0.001% to about 10% of a retinoid to provide a first benefit; said retinoid selected from a group consisting of retinyl esters, retinol, retinal, and mixtures thereof;

a second composition comprising about 0.0001% to about 50% of at least one retinoid booster to boost the first benefit;

said retinoid booster selected from the group consisting of CITRAL, CITRONELLOL, Climbazole, COCAMIDE DEA, DAMASCONE, GERANIOL, 18b GLYCERHETINIC ACID, 8 OH QUINOLINE, N LAURY SARCOSINE, LINALOOL, ALPHA IONONE and LINSEED OIL;

a first compartment for storing the first composition and isolating the first composition from the second composition, wherein the first compartment keeps the first composition out of contact with oxygen; and

a second compartment for storing the second composition and isolating the second composition from the first composition, wherein the second compartment keeps the second composition out of contact with oxygen;

further wherein the first, second or both compartments comprise aluminum; and the first and second compartments are joined together;

the first composition not being chemically degraded by the second composition and not coming into contact with the second composition when being stored in the first compartment and the second composition potentiates the action of the retinoid upon contact.

Claim 11 is further defined by the dependent claims which claim, among other things, that at least two retinoid boosters may be used and that the compositions within the product of claim 11 can condition skin. Moreover, claim 11 is further defined in that specific combinations of boosters are described.

In contrast, the '116 reference only discloses a first and second composition stored in separate containers joined together. The product described in the '116 reference includes a first composition for obtaining a first skin benefit and second composition for obtaining a second and different skin benefit wherein first and second actives in the compositions (respectively) yield benefits that are different from one another, and the two compositions are part of a regime that teaches or fosters applications at different times of the day (please see col. 2, lines 1-5). Contrary to the presently claimed invention, nothing in the '116 reference even remotely suggests a stable skin care product that has two compositions that are isolated from each other in different compartments prior to use. The first composition is kept in a compartment out of contact with oxygen and the first composition is not chemically degraded by the second composition and not coming into contact with the second composition when being stored in the first compartment. As set forth in independent claim 1, as amended, the second composition potentiates the action of retinoid upon contact with the first composition. Nowhere in the '116 reference is such a product even remotely suggested. In fact, the '116 reference merely describes a skin treatment regime requiring application of multiple separate compositions that can be sold in a single unit to serve as a reminder for joint usage and to also educate the consumer of proper application thereof. No composition described in the '116 reference boosts the performance of the other. The same is true and required of the stable skin care

products described in independent claim 6 and independent claim 11 as presented herein.

None of the vast deficiencies of the primary references, namely the '116 reference, are even remotely cured by the '518 reference since the '518 reference only discloses fragrance compositions having antimicrobial activity. The concept of isolating a composition with a retinoid booster from a composition with a retinoid in a dual compartment package is not even remotely addressed in the '518 reference. Turning to the '555 reference, the same only shows topical water-in-oil emulsions with retinoids.

The combination of references relied on by the Examiner does not, even remotely, suggest stable skin care products having two compositions that are isolated from each other in two compartments wherein the first composition has a retinoid that is kept out of contact with oxygen and that is boosted by the composition in the second compartment when the second composition is in contact with the first composition and further where the first composition is not chemically degraded by the second composition during storage. In view of this, it is clear that all the important and critical limitations set forth in the presently claimed inventions, as now presented and amended, are not even remotely described in the combination of references relied on by the Examiner. In view of this, Applicants respectfully request that the obviousness rejection be withdrawn and rendered moot.

## II. Rejection Under 35 USC §103

The Examiner has rejected claim 18 under 35 USC §103 and alleges that the same is obvious and unpatentable over U.S. Patent No. 5,941,116 (hereinafter, '116) in view of U.S. Patent No. 5,965,518 (hereinafter, '518) and further in view of U.S. Patent No.



5,976,555 (hereinafter, '555) as applied to claims 1-2, 4-7, 9-12, 14-15 and 17 above and further in view of JP 04183797 (hereinafter, '797). In the rejection, the Examiner mentions, in summary, that the '116, '518 and '555 references are relied on for the reasons set forth above. The Examiner admits that the references do not specifically recite the retinoid booster as disclosed in claim 18, and however, the Examiner relies on the '797 reference for describing ionone for use in cosmetics. In view of this, the Examiner believes that the rejection to claim 18 under 35 USC §103 is warranted.

Notwithstanding the Examiner's apparent position to the contrary, it is the Applicants' position that the presently claimed invention is patentably distinguishable from the above-described for at least the following reasons.

As already made of record, none of the references relied on by the Examiner in any combination even remotely describe a stable skin care product as described in claim 1 as now presented. This is true because the references relied on by the Examiner do not describe a dual component system that has two separate compositions isolated from each other wherein the first composition is also kept out of contact with oxygen. Moreover, the references relied on by the Examiner do not describe a first composition that is not chemically degraded by a second composition when being stored in the first compartment and further wherein the second composition potentiates the action of retinoid in the first composition upon contact. Therefore, none of the important and critical limitations set forth in the presently claimed invention are even remotely found in the combination of references relied on by the Examiner, and claim 18 is dependent on claim 1.

The deficiencies of the references relied on by the Examiner are not cured by the '797 reference since the same merely describes ionone perfumes in compositions like

cosmetics and solid soaps. In view of this, Applicants respectfully request that the obviousness rejection to claim 18 be withdrawn and rendered moot.

### III. Rejection Under 35 USC §103

The Examiner has rejected claim 16 under 35 USC §103 as being unpatentable over U.S. Patent No. 5,914,116 (hereinafter, '116) in view of U.S. Patent No. 5,965,518 (hereinafter, '518) and further in view of U.S. Patent No. 5,976,555 (hereinafter, '555) as applied to claims 1-2, 4-7, 9-12, 14-15 and 17 and further in view of JP 04183797 (hereinafter, '797) and U.S. Patent No. 5,582,832 (hereinafter, '832). In the rejection, the Examiner mentions, in summary, that the rejection to claims 1-2, 4-7, 9-12, 14-15 and 17 are made in view of the '116, '518, and '555 references. The Examiner relies on the '797 reference for reasons which appear to be the use of perfumes in cosmetic compositions and the '832 reference for describing compositions that use suitable azoles like climbazole when treating skin. In view of this the Examiner believes that claim 16 is appropriately rejected under 35 USC §103.

Notwithstanding the Examiner's apparent position to the contrary, it is the Applicants' position that the presently claimed invention is patentably distinguishable from the above-described for at least the following reasons.

As already made of record, independent claim 11 is directed to a stable skin care product that comprises a first composition and a second composition where the first composition is kept out of contact with oxygen and stored in a first compartment and the second composition is stored in a second compartment whereby the first composition and second composition are not in contact during storage. The invention

of claim 11 is further defined in that the first composition does not chemically degrade the second composition during storage and further wherein the second composition potentiates the action of the retinoid in the first composition upon contact. Nowhere in the combination of references relied on by the Examiner is such a stable skin care product even remotely described. Moreover, since the '832 reference merely describes the use of climazole formulated into compositions with sunscreen, the '832 reference does not cure any of the vast deficiencies of the prior references relied on by the Examiner. Again, the combination of references relied on by the Examiner does not describe a stable skin care product having a dual compartment system where the first composition is in the first compartment and the second composition is in the second compartment such that the second composition potentiates the action of retinoid in the first composition upon contact. In view of this, it is clear that all the important and critical limitations set forth in the presently claimed invention are not found in the combination of references relied on by the Examiner. Since a *prima facie* case of obviousness has not been established, Applicants request that the obviousness rejection be withdrawn and rendered moot.

Applicants submit all claims of record are now in condition for allowance.

Reconsideration and favorable action are earnestly solicited.

In the event the Examiner has any questions concerning the present patent application, she is kindly invited to contact the undersigned at her earliest convenience.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Edward A. Squillante, Jr.', written over a horizontal line.

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